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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,702	12/30/2003	Sultan Ahmad	ASZN0039-101 (A1807-2P US	2881

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EXAMINER	
LI, RUIXIANG	

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/747,702	AHMAD ET AL.	
	Examiner	Art Unit	
	Ruixiang Li	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-42 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 2, 41 (in part), drawn to rat dorsal root receptor 1 of SEQ ID NO: 1, classified in class 530, subclass 350.

II. Claims 3-5, 38, and 40 (in part), drawn to a polynucleotide encoding the rat dorsal root receptor 1 of SEQ ID NO: 1, an expression vector, and a host cell, classified in class 536, subclasses 23.5 and 24.3; class 435, subclass 320.1, and 325.

III. Claims 6, 7, and 41 (in part), drawn to human dorsal root receptor 1 of SEQ ID NO: 3, classified in class 530, subclass 350.

IV. Claims 8-10, 39 (in part) and 40 (in part), drawn to a polynucleotide encoding the human dorsal root receptor 1 of SEQ ID NO: 3, an expression vector, and a host cell, classified in class 536, subclasses 23.5 and 24.3; class 435, subclass 320.1, and 325.

V. Claims 11,12, and 41 (in part), drawn to human dorsal root receptor 2 of SEQ ID NO: 5, classified in class 530, subclass 350.

VI. Claims 13-15, 39 (in part) and 40 (in part), drawn to a polynucleotide encoding the human dorsal root receptor 2 of SEQ ID NO: 5, an expression vector, and a host cell, classified in class 536, subclasses 23.5 and 24.3; class 435, subclass 320.1, and 325.

VII. Claims 16, 17, and 41 (in part), drawn to human dorsal root receptor 3 of SEQ ID NO: 7, classified in class 530, subclass 350.

VIII. Claims 18-20, 39 (in part) and 40 (in part), drawn to a polynucleotide encoding the human dorsal root receptor 3 of SEQ ID NO: 7, an expression vector, and a host cell, classified in class 536, subclasses 23.5 and 24.3; class 435, subclass 320.1, and 325.

IX. Claims 21, 22, and 41 (in part), drawn to human dorsal root receptor 4 of SEQ ID NO: 9, classified in class 530, subclass 350.

X. Claims 23-25, 39 (in part) and 40 (in part), drawn to a polynucleotide encoding the human dorsal root receptor 4 of SEQ ID NO: 9, an expression vector, and a host cell, classified in class 536, subclasses 23.5 and 24.3; class 435, subclass 320.1, and 325.

XI. Claims 26, 27, and 41 (in part), drawn to human dorsal root receptor 5 of SEQ ID NO: 11, classified in class 530, subclass 350.

XII. Claims 28-30, 39 (in part) and 40 (in part), drawn to a polynucleotide encoding the human dorsal root receptor 5 of SEQ ID NO: 11, an expression vector, and a host cell, classified in class 536, subclasses 23.5 and 24.3; class 435, subclass 320.1, and 325.

XIII. Claims 31, 32, and 41 (in part), drawn to human dorsal root receptor 6 of SEQ ID NO: 13, classified in class 530, subclass 350.

XIV. Claims 33-35, 39 (in part) and 40 (in part), drawn to a polynucleotide encoding the human dorsal root receptor 6 of SEQ ID NO: 13, an expression vector, and a host cell, classified in class 536, subclasses 23.5 and 24.3; class 435, subclass 320.1, and 325.

XV. Claims 36 and 37 (both in part), drawn to an antibody, classified in class 530, subclass 387.9.

XVI. Claim 42 (in part), drawn to a method for assaying a test compound for its ability to bind a dorsal root ganglio specific receptor, classified in class 435, subclass 7.1.

XVII. Claim 42 (in part), drawn to a method for assaying a test compound for its ability to activate a dorsal root ganglio specific receptor, classified in class 435, subclass 5.

2. The inventions are distinct, each from the other for the following reasons. Inventions I-XV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §806.04, MPEP §808.01). In the instance case, the different inventions are drawn to completely different products, proteins, polypeptides, and antibodies. These molecules have completely different structures and biological functions which are not interchangeable and which require non-cohesive searches and considerations.

3. Inventions XVI and XVII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §806.04, MPEP §808.01). In the instance case the different inventions are drawn to completely different methods each having completely different method steps, using different compositions, and having completely different outcomes. Invention Group XVI

requires measuring the binding of a compound to a dorsal gangio specific receptor, whereas Invention Group XVII requires measuring the ability of a compound to activate a dorsal gangio specific receptor. Thus, the methods are exclusive and require non-cohesive searches and considerations.

4. Inventions I, III, V, VII, IX, XI, and XIII are related to Inventions XVI and XVII as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP§806.05 (h)). In the instant case, a protein may be used to produce an antibody.
5. Invention XV is related to Inventions XVI and XVII as distinct inventions. The different inventions are drawn to distinct product and method inventions because the product cannot be used in the methods.
6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
7. Because these inventions are distinct for the reasons given above and the search required for a single group is not required for any other group, restriction for examination purposes as indicated is proper.
8. Furthermore, the application contains claims which are directed to numerous amino acid/nucleic acid sequences as represented by different SEQ ID NOS. Each individual sequence represents a structural and functionally distinct entity that is

capable of supporting a separate patent. The search and consideration of more than a single sequence constitutes an undue search burden on the office, given the ever-increasing size of the database.

Should applicants elect Invention Groups XV, XVI, or XVII, Applicant is advised that a reply to this requirement must include an identification of an amino acid that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. **The Examiner notes that this is not a species election requirement; rather it sets forth additional invention groups.**

9. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be

allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (I).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (571) 272-0875. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at the toll-free phone number 866-217-9197.

Ruixiang Li

Ruixiang Li, Ph.D.
Primary Examiner
January 13, 2005